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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/776,085      | 02/11/2004  | Dilip Tapadiya       | TAPADI.003C3        | 2366             |

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EXAMINER

BOGART, MICHAEL G

ART UNIT PAPER NUMBER

3761

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/776,085             | TAPADIYA, DILIP     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Michael G. Bogart      | 3761                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 122-133 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 122-133 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

The drawings filed 09 August 2004 and 08 February 2006 are informal and are acceptable for examination purposes only.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “(134’)” has been used to designate both the inner recess of the adapter (126’) and the inner recess of the tubing (5’). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 127 is objected to because of the following informalities:

The use of “ends” in line 7 is potentially unclear as it could be interpreted as meaning the ends of the hose. Appropriate correction is required.

***Claim Rejections – 35 USC § 102***

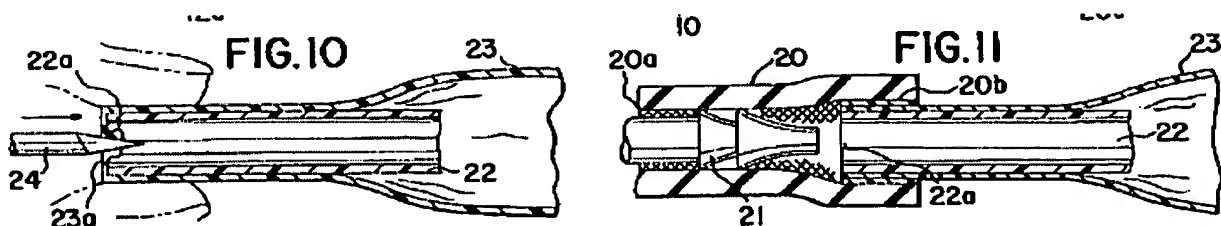
The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 127 and 130-133 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bryan *et al.* (US 5,582,165 A).

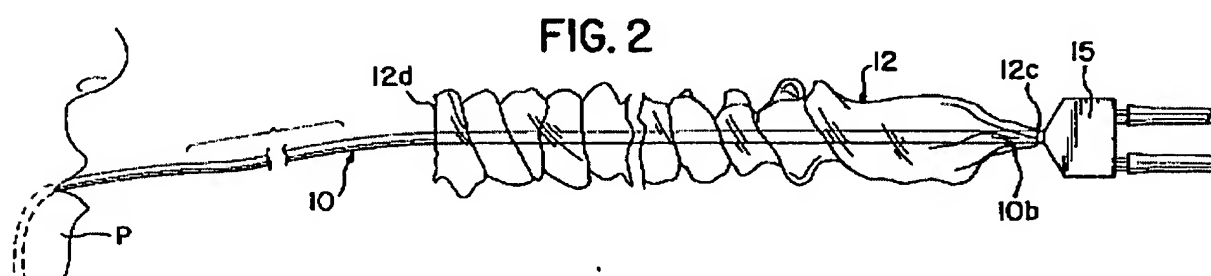
Regarding claim 127, Bryan *et al.* teach a medical hose kit comprising a sterilized package (23) containing a sterilized length of hose (10, 22), the hose (10, 22) having first and second hose ends, a first hose outer diameter and a first hose inner diameter, at least a first connector (20) disposed at the first end, the first connector (20) having a first connector end (20b) defining first connector inner diameter, a second connector end (20a) defining a second connector inner diameter, and a partition (21) disposed between the first and second ends and defining a third connector inner diameter that is smaller than both of the first and second inner diameters, the first connector inner diameter being about the same as the first hose (10, 22) outer diameter such that the first end of the hose fits into the first connector end (20b), the second connector inner diameter being smaller than the first connector inner diameter (column 4, lines 30-48)(see figure 11, below).



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Regarding claim 130, Bryan *et al.* teach that the catheter (10, 22) is a suction hose that is applied for endotracheal suctioning. Structurally, this hose meets all the limitations of the claimed suction hose.

Regarding claims 131-133, Bryan *et al.* teach that the first connector (20, 21) is connected to a suction device that may be held by hand (10)(see figure 2, below).



### *Claim Rejections – 35 USC § 103*

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 122-126 and 128 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bryan *et al.*

Regarding claim 122, Bryan *et al.* teach a medical kit comprising a sterilized package (12, 23) containing a sterilized length of suction hose (10, 22).

Bryan *et al.* do not teach the specifically claimed inner diameter of the suction hose.

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Mere changes in the relative size of an element are not sufficient to patentably distinguish a claimed invention over the prior art. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

Regarding claim 123, Bryan *et al.* teach a length of suction hose (27) which includes first and second ends, and first (14, 20) and second female (25) adapters connected to the first and second ends, respectively.

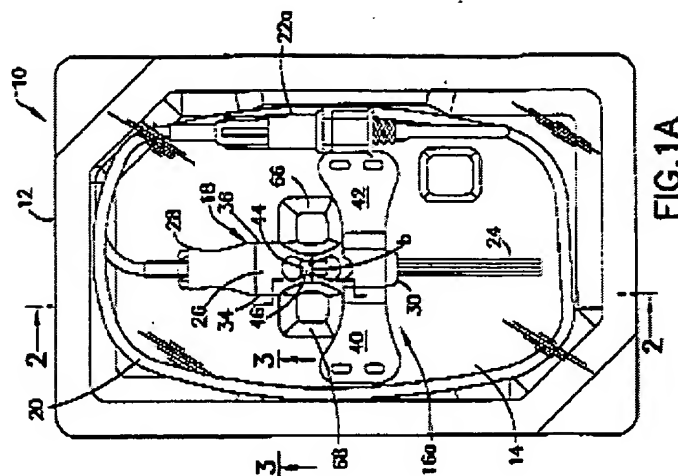
Regarding claims 124 and 128, Bryan *et al.* teach that the first female adapter (14, 20) is configured to be connectable with an outlet of a suction device (10, 20). Regarding the specific diameter, see the discussion of claim 122, *supra*.

Regarding claims 125 and 126, Bryan *et al.* teach that the first connector (20, 21) is connected to a suction device than can be held by hand (10)(figure 2).

Claim 129 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bryan *et al.* as applied to claims 127 and 130-133 above, and further in view of Giard, Jr. *et al.* (US 2003/0062281 A1).

Bryan *et al.* do not expressly disclose that the suction hose is coiled inside the package.

Giard, Jr. *et al.* teach packaging (12) for a medical collection device that includes a coiled tube (20)(see figure 1A, below).



At the time of the invention, it would have been obvious to one of ordinary skill in the art to adopt the coiled tube configuration of Giard, Jr. *et al.* for the kit of Bryan *et al.* in order to provide a compact kit size for storage.

### ***Response to Arguments***

Applicant's arguments filed 08 February 2006 have been fully considered but they are not persuasive. Applicants assert that Bryan *et al.* do not teach a suction hose and a connector with first, second and third inner diameters. Regarding the "suction hose" limitation, see col. 1, lines 56-57. Regarding the first, second and third inner diameters, see the enumerated rejection of claim 127, *supra*, and figure 11.

Regarding the rejection of claims 122-126 and 128, applicants assert that the claimed invention would perform differently than that of Bryan *et al.* because this size permits compatibility with operating room hoses. This is not persuasive because this is not evidence that it performs differently, only that is compatible with operating hoses of a certain diameter. One of ordinary skill in the art would have recognized the need to size the connector to fit whatever

suction source that the device was intended to be used with. How it functions is the same, it connects to a source and allows negative pressure to be applied to the suction hose.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.


In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Bogart  
24 April 2006

**TATYANA ZALUKAEVA**  
**SUPERVISOR - PRIMARY EXAMINER**

